



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

102

| APPLICATION NO.                          | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------|---------------------|------------------|
| 09/925,109                               | 08/08/2001  | Millard E. Sweatt III | 22407-05391         | 2738             |
| 20306                                    | 7590        | 06/27/2005            | EXAMINER            |                  |
| MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP |             |                       |                     | SHAH, KAMINI S   |
| 300 S. WACKER DRIVE                      |             |                       |                     | ART UNIT         |
| 32ND FLOOR                               |             |                       |                     | PAPER NUMBER     |
| CHICAGO, IL 60606                        |             |                       |                     | 2142             |

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                            |                  |
|------------------------------|----------------------------|------------------|
| <b>Office Action Summary</b> | Application No.            | Applicant(s)     |
|                              | 09/925,109                 | SWEATT ET AL.    |
|                              | Examiner<br>Kamini S. Shah | Art Unit<br>2142 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 March 2005.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20,35-37,58 and 60-75 is/are pending in the application.  
 4a) Of the above claim(s) 21-34,38-57 and 59 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20,35-37,58 and 60-75 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/01,1/02,6/02</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1 and 35 are objected to because of the following informalities: In the preamble, "remotely control *his* media-based device" should refer to "a" in accordance to U.S. practice. Appropriate correction is required.

### ***Specification***

2. The attempt to incorporate subject matter into this application by reference to several co-pending applications is ineffective because appropriate application numbers are not provided.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20, 35-37 and 60-75 are rejected under 35 U.S.C. 101 because claimed invention contains non-functional descriptive material (i.e., web servers, data fields) and includes software, or signals, *per se* that are not tangibly embodied on or in some form of computer readable medium.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-20, 35-37, 58 and 60-75 are rejected under 35 U.S.C. 102(e) as being anticipated by Scott et al US patent no. 6,338,094.

With regards to claim 1,35 and 60, Scott teaches a method of programming a media-based device over a network, the method comprising: receiving a user request from the user, Scott teaches a design for playing a video in response to a webpage link locating an advertisement for a broadcast program while navigating a first web site; in response to the at least one function call/request, executing at least one application program to retrieve from at least one database data concerning the media-based device, Scott's design allows users to click on a link (or banner) to download (equivalent to record) and view a TV file (program) on the computer or television (column 4, lines 30-46, Scott). Furthermore, with regard to one database being in communication with the media-based device through a second network, Scott teaches the method wherein the advertisement comprises a hyperlink to a second web site accessing the media-based

device, the hyperlink being embedded in the first web site (Scott teaches a design allowing users to click on links or banners (column 3, lines 60-67, Scott).

Regarding claims 2-20, for claiming various media-based device features, Scott teaches web server executing web-hosted application, the HTTP command format, the XML format and a channel line up corresponding to certain value of a least one specified show attribute, see whole document.

Regarding claims 35-36, 58 and 60-75, claims covers the similar subject matter as the claims 1-20, therefore claims are rejected for the similar reasoning.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamini S. Shah whose telephone number is 571-272-2279. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew B. Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/925,109  
Art Unit: 2142

Page 5



Kamini S Shah  
Primary Examiner  
Art Unit 2142

kss